



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Paul H. KAYE *et al.*

Appln. No.: 10/010,613

Filed: December 5, 2001

For: Coded Items for Labeling Objects

Art Unit: 2876

Examiner: Edwyn Labaze

Confirmation No.: 1920

Atty. Docket: 17893.006

**PETITION UNDER 37 C.F.R. § 1.55 TO ACCEPT AN  
UNINTENTIONALLY DELAYED PRIORITY CLAIM<sup>1</sup>**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants hereby petition to request entry in the above-referenced application of an unintentionally delayed claim for the benefit of priority as stated in the accompanying Amendment<sup>2</sup> and Declaration.<sup>3</sup> The Amendment that accompanies this Petition provides for a priority claim that is identical to that set forth in Applicants' Preliminary Amendment filed on July 11, 2002. The entire delay in making the present claim for priority was unintentional.

<sup>1</sup> Applicants note that if the U.S. Patent and Trademark Office deems that any of the priorities as listed below in footnote 2 were not effective prior to the present petition and may be added by a petition under 35 U.S.C. § 120, then Applicants hereby petition under 37 C.F.R. § 1.78 to accept the unintentionally delayed priority claim as presented below in footnote 2. **Applicants hereby specifically authorize any fee associated with a petition to accept an unintentionally delayed priority claim as stated below in footnote 2. A duplicate copy of this page is included.**

<sup>2</sup> As stated in the accompanying Amendment, Applicants note that the captioned application is a continuation-in-part under 35 U.S.C. § 120 of U.S. Application No. 09/565,426, filed May 5, 2000, now abandoned, which application is a continuation under 35 U.S.C. § 120 of 08/737,532, with a filing date of October 25, 1996 and a 371 (c) date of July 16, 1997, now abandoned, which application is a 35 U.S.C. § 371 national stage entry of PCT/GB95/00756, filed March 31, 1995, which application claims the benefit under 35 U.S.C. § 119 of Great Britain Application No. GB9408169.2, filed April 25, 1994, and the captioned application is a continuation-in-part under 35 U.S.C. § 120 of U.S. Application No. 09/634,514, filed August 8, 2000, now abandoned, which application is a continuation under 35 U.S.C. § 120 of U.S. Application No. 09/066,296, filed April 27, 1998, now abandoned, which application is a 35 U.S.C. § 371 national stage entry of PCT/GB96/02617, filed October 25, 1996, which application claims the benefit under 35 U.S.C. § 119 of Great Britain Application No. GB9521943.2, filed October 26, 1995.

<sup>3</sup> An unsigned copy of a Declaration is provided herewith for the convenience of the Office, and a signed copy will be provided in due course.

10010613

00000008 502387

12/17/2004 ANAB11

1370.00 DA

02 FC:1454

As discussed in more detail below, Applicants requested that the captioned application be filed with a benefit claim that included Great Britain Applications GB9408169.2 and GB9521943.2. At filing, Applicants' prior counsel omitted priority claims to certain applications, including these two GB applications. Upon transfer of the above-captioned application to Arnold & Porter, a Preliminary Amendment was filed, requesting entry of an amendment to the specification that included Applicants' priority claims to GB9408169.2 and GB9521943.2. A Declaration, filed on September 12, 2002, listed benefit claims to 09/565,426, 08/737,532, PCT/GB95/00756, and GB9408169, inadvertently omitting Applicants' priority claims to 09/634,514, 09/066,296, PCT/GB96/02617, and GB9521943.2. As such, Applicants note that the entire delay in making a priority claim back through to GB9408169.2 and GB9521943.2 was unintentional. Grant of the instant Petition and entry of the accompanying Amendment is respectfully requested.

#### Detailed Facts

On December 5, 2001, the above-captioned application, U.S. Application No. 10/010,613 was filed. Applicants' instructions to the prior patent counsel stated that "[w]e have agreed to proceed with filing of a continuation in part application now replacing this current US patent application 09/565,426." Exhibit A. Applicants stated that "...this is essentially the same as the existing continuation case but incorporates a drawing that comes directly from the present client's continuation US Patent Application Serial No. 09/634,514 and which is a continuation of US Patent Application No. 09/066,296 of 27 April 1998 under the national phase of PCT Application No. PCT/GB96, 02617, and carrying a first filing date of 25 October 1996 and priority date of 25 April 1994 (UK application no. 9408169.2)." *Id.* Applicants instructed that "[i]n filing this continuation in part application would you please claim not only the date of the present Continuation Application No. 09/565,426 but also of this other US Continuation case 09/634,514 right back to the PCT Application and its UK priority." *Id.*

The original declaration lists applications PCT/US95/00756 (*sic*, properly PCT/GB95/00756); PCT/GB96/02617; 08/737,532; 09/634,514; and 09/066,296 and omits benefit claims to PCT/US95/00756 (*sic*, properly PCT/GB95/00756); PCT/GB96/02617; 09/565,426; GB9408169.2; and GB9521943.2. *See* Exhibit B. Claims including those to

PCT/US95/00756 (*sic*, properly PCT/GB95/00756); PCT/GB96/02617; and U.S. Application No. 09/565,426 were noted by Applicants in the first paragraph of the specification as filed and by the Office on the Filing Receipt mailed January 2, 2002. *See* Exhibit C for first page of specification and Exhibit D for Filing Receipt mailed January 2, 2002.

After the April 5, 2002 deadline for priority had passed, various documents, including the Filing Receipt mailed January 2, 2002, were forwarded from prior counsel to Arnold & Porter. On July 11, 2002, Applicants' representative filed a Preliminary Amendment, requesting amendment of the specification to include Applicants' priority claims, including to Great Britain Applications GB9408169.2, filed April 25, 1994 and GB9521943.2, filed October 26, 1995.<sup>4</sup> *See* Exhibit E. On September 12, 2002, Applicants filed a substitute "Combined Declaration and Power of Attorney for Patent Application." *See* Exhibit F. The substitute Declaration listed priority claims to GB9408169.2; PCT/GB95/00756; 08/737,532; and 09/565,426, omitting Applicants' priority claims to 09/634,514; 09/066,296; PCT/GB96/02617; and GB9521943.2.<sup>5</sup>

On July 17, 2003, the Office Action stated that "[t]his application claims the benefits of parent applications domestic 08/737,532 filed on 10/25/1996; 09/634,514 filed on 08/08/2000; 09/066,296 filed on 04/27/1998 and foreign PCT US95/00756 filed on 03/15/1995 and PCT GB96/02617 filed on 10/25/1996." Office Action mailed July 17, 2003. As such, the Office Action failed to recognize Applicants' priority claim to 09/565,426, which was included in the specification as filed and was recognized on the Filing Receipt that had previously been mailed by the U.S. Patent and Trademark Office on January 2, 2002. In addition, the Office Action did not comment on Applicants' attempt to amend the specification to include priority claims to GB9408169.2 and GB9521943.2 in the Preliminary Amendment filed on July 11, 2002. The Office Action also did not comment upon Applicants' Declaration filed September 12, 2002, which Declaration did not match either the Office's assertion or the Applicants' Preliminary Amendment.

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<sup>4</sup> The Preliminary Amendment was not accompanied by a Petition under 37 C.F.R. § 1.55 and a fee under 37 C.F.R. § 1.17(t).

<sup>5</sup> Applicants' Declaration filed September 12, 2002 was filed in error, not conforming to Applicants' previous Amendment.

Conclusion

A claim for priority is made herewith by the filing of an Amendment, a Petition to Accept an Unintentionally Delayed Priority Claim and a payment of the fee under 37 C.F.R. § 1.17(t).<sup>6</sup>

In light of the above, Applicants assert that the entire delay in making the claim for the benefit of priority was unintentional. As such, Applicants respectfully request grant of the present Petition and entry of the attached Amendment.

Please feel free to contact the undersigned directly at (202) 942-5325 if any additional information is requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "D. R. Marsh".

David R. Marsh (Reg. No. 41,408)

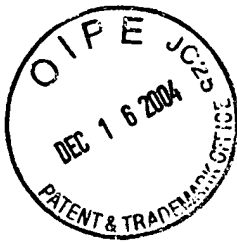
Lisa A. Adelson (Reg. No. 51,204)

Date: December 16, 2004

ARNOLD & PORTER LLP  
555 12<sup>th</sup> Street, N.W.  
Washington, D.C. 20004  
(202) 942-5000 telephone  
(202) 942-5999 facsimile

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<sup>6</sup> In the accompanying transmittal letter, the Commissioner has been authorized to charge the required fee for the Present Petition, \$1370.00, in accordance with 37 C.F.R. § 1.55(c)(2) and 1.17(t), to Arnold & Porter LLP Deposit Account No. 50-2387, referencing matter number 70750.100. Also in the accompanying transmittal letter, Applicants have authorized the Commissioner to charge any additional fees that may be required in the above-captioned application.



PA2747 US  
(now PA4215US)

Kit Stetina  
Stetina Brunda Garred & Brucker  
75 Enterprise, Suite 250  
Aliso Viejo  
CALIFORNIA 92656

31 October 2001

Patent & Trademark Office

Phone 2 - 44 00 77 898 72

Our Ref: **IW/PA4215 US**

Dear Kit

US Patent Application No. 09/565,426 continuation of 08/737,532 corresponding to  
International Patent Application No. PCT/GB95/00756  
**Coded Items for Labelling Objects**

Thank you for your opinion given by telephone on whether we should be filing continuation in part or interviewing the case.

We have agreed to proceed with filing of a continuation in part application now replacing this current US patent application 09/565,426. The text and drawings for this follow.

As you will see, this is essentially the same as the existing continuation case but incorporates a drawing that comes directly from the present client's continuation US Patent Application Serial No. 09/634,514 and which is a continuation of US Patent Application No. 09/066,296 of 27 April 1998 under the national phase of PCT Application No. PCT/GB96,02617, and carrying a first filing date of 25 October 1996 and priority date of 25 April 1994 (UK application no. 9408169.2). A copy of USSN 09/634,514 is enclosed together with a copy of the earlier published PCT application.

In filing this continuation in part application would you please claim not only the date of the present Continuation Application No. 09/565,426 but also of this other US Continuation case 09/634,514 right back to the PCT Application and its UK priority.

As noted, although the majority of that other specification 09/634,514 is concerned with combinatorial chemistry micro particles it does specifically disclose micro particles of silicon that are etched with through holes or notches, including a drawing.

65



Kit Stetina  
31 October 2001  
page 2

Please note that we have throughout the new claims specified that the particle is etched through with holes or notches. In my last letter and amendments I restricted the claims to through holes or notches in a micro-particle to be distinctive over the prior art and noted that this achieved the benefits of allowing for light transmission through the configuration defining the mark for better resolution of the mark. The arguments still stand and I do think that the Examiner should now accept that the claimed invention is truly novel and inventive over the cited prior art.

We look forward to receiving your confirmation of filing of the application and to receiving the filing details in due course.

Kind regards,

Yours sincerely

**IAIN WHITAKER**



PTO/SB/01 (12-97)

†

Please type a plus sign (+) inside this box → ☐Approved for use through 09/30/2000. OMB 0651-0032  
Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>DECLARATION FOR UTILITY OR DESIGN PATENT APPLICATION (37 CFR 1.63)</b>  <input type="checkbox"/> Declaration Substantive OR Substantive after Initial Filing  <input checked="" type="checkbox"/> Declaration Substantive after Initial Filing (surcharge (37 CFR 1.14(e) required)	Attorney Docket Number	SOMMR-002USCB
	First Named Inventor	P. KAYE ET AL.
	COMPLETE IF KNOWN	
	Application Number	10/010,613
	Filing Date	December 5, 2001
	Group Art Unit	2876
	Examiner Name	K. FRECH

As a below named inventor, I hereby declare that:

My residence, post office address, and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

## CODED ITEMS FOR LABELING OBJECTS

the specification of which

☐ is attached hereto  
OR☒ was filed on (MM/DD/YYYY) 12-05-2001 as United States Application Number or PCT International  
Application Number 10/010,613 and was amended on (MM/DD/YYYY) \_\_\_\_\_ (if applicable).

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims as amended by any amendment specifically referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56.

I hereby claim foreign priority benefits under 35 U.S.C. 119(a)-(d) or 365(b) of any foreign application(s) for patent or inventor's certificate or 365(a) of any PCT international application which designated at least one country other than the United States of America, listed below and have also identified below, by checking the box, any foreign application for patent or inventor's certificate, or of any PCT international application having a filing date before that of the application on which priority is claimed.

Prior Foreign Application Number(s)	Country	Foreign Filing Date (MM/DD/YYYY)	Priority Not Claimed	Certified Copy Attached	
				YES	NO
PCT US95/00756 PCT GB96/02617	PCT PCT	03/15/95 10/25/96	X X <input type="checkbox"/> <input type="checkbox"/>	<input type="checkbox"/> <input type="checkbox"/> <input type="checkbox"/> <input type="checkbox"/>	X X <input type="checkbox"/> <input type="checkbox"/>

☐ Additional foreign application numbers are listed on a supplemental priority data sheet PTO/SB/02B attached hereto:

I hereby claim the benefit under 35 U.S.C. 119(e) of any United States provisional application(s) listed below.

Application Number(s)	Filing Date (MM/DD/YYYY)	<input type="checkbox"/> Additional provisional application numbers are listed on a supplemental priority data sheet PTO/SB/02B attached hereto.

[Page 1 of 2]



PTO/SB/01 (12-97)

†

Please type a plus sign (+) inside this box → ☐Approved for use through 09/30/2000. OMB 0651-0032  
Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**DECLARATION — Utility or Design Patent Application**

I hereby claim the benefit under 35 U.S.C. 120 of any United States application(s), or 365(c) of any PCT international application designating the United States of America, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States or PCT international application in the manner provided by the first paragraph of 35 U.S.C. 112, I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56 which became available between the filing date of the prior application and the national or PCT international filing date of this application.

U.S. Parent Application or PCT Parent Number	Patent Filing Date (MM/DD/YYYY)	Parent Patent Number (if applicable)
08/737,532 09/634,514 09/066,296	10/25/96  04/27/1998	

☐ Additional U.S. or PCT international application numbers are listed on a supplemental priority data sheet PTO/SB/02 attached hereto.

As a named inventor, I hereby appoint the following registered practitioner(s) to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith: ☐ Customer Number \_\_\_\_\_ → Place Customer No. Bar Code Label Here  
OR  
☐ Registered practitioner(s) name/registration number listed below

Name	Registration Number	Name	Registration Number

☐ Additional registered practitioner(s) named on supplemental Registered Practitioner Information sheet PTO/SB02C attached hereto.

Direct all correspondence to: ☐ Customer Number \_\_\_\_\_ OR ☒ Correspondence Address Below  
or Bar Code Label \_\_\_\_\_

Name	Kit M. Stetina					
Address	STETINA BRUNDA GARRED & BRUCKER					
Address	75 Enterprise, Suite 250					
City	Aliso Viejo	State	CA	ZIP	92656	
Country	U.S.A.	Telephone	(949) 855-1246	Fax	(949) 8955-6371	

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Name of Sole or First Inventor:		<input type="checkbox"/> A petition has been filed for this unsigned inventor					
Given Name (first and middle (if any))				Family Name or Surname			
PAUL H.				KAYE			
Inventor's Signature				Date	13.02.02		
Residence: City	KIMPTON	State		Country	GB	Citizenship	GB
Post Office Address	1 Coopers Close						
Post Office Address							
City	Kimpton	State	Herts.	ZIP	SG4 8QU	Country	GB

☐ Additional inventors are being named on the \_\_\_\_\_ supplemental Additional Inventor(s) sheet(s) PTO/SB02A attached hereto.





Please type a plus sign (+) inside this box → ☐

PTO/SB/02A (11-00)  
Approved for use through 10/31/2002. OMB 0651-0032

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

## DECLARATION

ADDITIONAL INVENTOR(S)  
Supplemental Sheet  
Page \_\_\_ of \_\_\_

Name of Additional Joint Inventor, if any:		<input type="checkbox"/> A petition has been filed for this unsigned inventor	
Given Name (first and middle (if any))		Family Name or Surname	
Mark C.		Tracey	
Inventor's Signature		Date 13.02.02	
Residence: City	Hertford Heath	State	Herts. Country GB
Citizenship GB			
Mailing Address 5 The Old School			
Mailing Address Mount Pleasant			
City	Hertford Heath	State	Herts. ZIP SG13 7QX Country GB
Name of Additional Joint Inventor, if any:		<input type="checkbox"/> A petition has been filed for this unsigned inventor	
Given Name (first and middle (if any))		Family Name or Surname	
John A.		Gordon	
Inventor's Signature		Date 13.02.02	
Residence: City	Datchworth Green	State	Herts. Country GB
Citizenship GB			
Mailing Address Lynfield House			
Mailing Address			
City	Datchworth Green	State	Herts. ZIP SG3 6TT Country GB
Name of Additional Joint Inventor, if any:		<input type="checkbox"/> A petition has been filed for this unsigned inventor	
Given Name (first and middle (if any))		Family Name or Surname	
Inventor's Signature		Date	
Residence: City		State	
Country			
Citizenship			
Mailing Address			
Mailing Address			
City		State	
ZIP			
Country			

Burden Hour Statement: This form is estimated to take 21 minutes to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.



-1-

Case **SOMMR-002USCB**

## CODED ITEMS FOR LABELING OBJECTS

### CROSS-REFERENCE TO RELATED APPLICATIONS

**[0001]** The present invention is a continuation-in-part application of United States Serial No. 09/565,426 filed May 5, 2000 entitled CODED MICROPARTICLE IDENTIFICATION LABELS FOR PLACEMENT ON OBJECTS, which is a continuation application of United States Serial No. 08/737,532 filed October 25, 1996, which is the United States National Phase Under 35 U.S.C. §371 of International Application PCT/US95/00756 filed March 15, 1995, and is a continuation-in-part application of United States Serial No. 09/634,514 entitled CODED PARTICLES FOR PROCESS SEQUENCE TRACKING IN COMBINATORIAL COMPOUND LIBRARY PREPARATION which is a continuation application of United States Serial No. 09/066,296 filed April 27, 1998 which is the United States National Phase filing under 35 U.S.C. §371 of International Application PCT/GB96/02617 filed October 25, 1996.

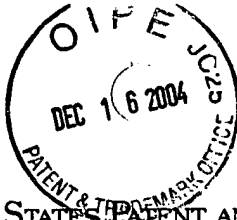
STATEMENT RE: FEDERALLY SPONSORED RESEARCH/DEVELOPMENT

**[0002]** (Not Applicable)

### BACKGROUND OF THE INVENTION

**[0003]** This invention relates to coded items for labeling objects such as vehicles, credit cards and jewelry, and is particularly useful for the invisible labeling of such objects with security marks to enable the objects to be identified or their origin to be identified.

**[0004]** Many methods are employed to protect merchantable items from theft or forgery. Car chassis and engines have serial numbers, credit cards have holographic icons, etc.



## UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
www.uspto.gov

APPLICATION NUMBER	FILING DATE	GRP ART UNIT	FIL FEE REC'D	ATTY. DOCKET NO	DRAWINGS	TOT CLAIMS	IND CLAIMS
10/010,613	12/05/2001	2876	801	SOMMR-002USCB	1	27	8

CONFIRMATION NO. 1920

## FILING RECEIPT



\*OC000000007250748\*

Kit M. Stetina  
STETINA BRUNDA GARRED & BRUCKER  
Suite 250  
75 Enterprise  
Aliso Viejo, CA 92656

Date Mailed: 01/02/2002

Receipt is acknowledged of this nonprovisional Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Customer Service Center. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).**

## Applicant(s)

Paul H. Kaye, Kimpton, UNITED KINGDOM;  
Mark C. Tracey, Hertford Heath, UNITED KINGDOM;  
John A. Gordon, Datchworth Green, UNITED KINGDOM;

## Domestic Priority data as claimed by applicant

THIS APPLICATION IS A CIP OF 09/565,426 05/05/2000  
WHICH IS A CON OF 08/737,532 07/16/1997 ABN \*  
WHICH IS A 371 OF PCT/US95/00756 01/20/1995 \*  
AND A CIP OF 09/634,514 08/08/2000  
WHICH IS A CON OF 09/066,296 04/27/1998 ABN  
WHICH IS A 371 OF PCT/GB96/02617 10/25/1996  
(\*) Data inconsistent with PTO records.

## Foreign Applications

If Required, Foreign Filing License Granted 12/31/2001

Projected Publication Date: To Be Determined - pending completion of Missing Parts

Non-Publication Request: No

Early Publication Request: No

**\*\* SMALL ENTITY \*\*****Title**

Coded items for labeling objects

**Preliminary Class**

235

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**LICENSE FOR FOREIGN FILING UNDER  
Title 35, United States Code, Section 184  
Title 37, Code of Federal Regulations, 5.11 & 5.15**

**GRANTED**

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Office of Export Administration, Department of Commerce (15 CFR 370.10 (j)); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

**NOT GRANTED**

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:

Paul H. KAYE *et. al*

Appl. No. 10/010,613

Filed: December 5, 2001

Title: Coded Items for Labeling Objects

Art Unit: 2876

Examiner: To be assigned

Atty. Docket: 17893.006

**Preliminary Amendment**

Commissioner for Patents  
Washington, D.C. 20231

Sir:

Prior to examination on the merits, please amend the above-referenced application as requested herein.

**In the Specification:**

On Page 1, Please delete paragraph [0001] and replace it with the following paragraph:

--The present invention is a continuation-in-part application of United States Serial No. 09/565,426 filed May 5, 2000 entitled CODED MICROPARTICLE IDENTIFICATION LABELS FOR PLACEMENT ON OBJECTS, which is a continuation application of United States Serial No. 08/737,532, which is the United States National Phase filing under 35 U.S.C. § 371 of International Application PCT/GB95/00756 filed March 31, 1995, which claims the benefit of Great Britain Application GB 9408169.2 filed April 25, 1994, and the present invention is also a continuation-in-part application of United States Serial No. 09/634,514 filed

August 8, 2000 entitled CODED PARTICLES FOR PROCESS SEQUENCE TRACKING IN COMBINATORIAL COMPOUND LIBRARY PREPARATION which is a continuation application of United States Serial No. 09/066,296, which is the United States National Phase filing under 35 U.S.C. § 371 of International Application PCT/GB96/02617 filed October 25, 1996, which claims the benefit of Great Britain Application GB 9521943.2 filed October 26, 1995.--

**In the Claims:**

Please add the following claims, and then please cancel claims 1-27.

28. A microparticle that is marked with a machine readable code, wherein said microparticle has a thickness of  $0.1\mu$  to  $5.0\mu$ , a width of  $0.5\mu$  to  $50\mu$ , and a length of  $0.5\mu$  to  $50\mu$ .
29. The microparticle of claim 28, wherein said microparticle is formed from a wafer.
30. The microparticle of claim 28, wherein said microparticle comprises silicon, silicon dioxide, or a metal.
31. The microparticle of claim 30, wherein said microparticle comprises silicon.
32. The microparticle of claim 30, wherein said microparticle comprises silicon dioxide.
33. The microparticle of claim 30, wherein said microparticle comprises aluminum, silver, or gold.
34. The microparticle of claim 28, wherein said machine readable code is readable by an optical device.
35. The microparticle of claim 28, wherein said machine readable code comprises data representing more than one bit.

36. The microparticle of claim 28, wherein said microparticle has a shape representative of a unique code.
37. The microparticle of claim 28, wherein said microparticle defines pits, holes, or notches that represent a machine readable code.
38. A tagging compound comprising a microparticle that is marked with a machine readable code, wherein said microparticle has a thickness of  $0.1\mu$  to  $5.0\mu$ , a width of  $0.5\mu$  to  $50\mu$ , and a length of  $0.5\mu$  to  $50\mu$ .
39. The tagging compound of claim 38, wherein said microparticle is formed from a wafer.
40. The tagging compound of claim 38, wherein said microparticle comprises silicon, silicon dioxide, or a metal.
41. The tagging compound of claim 40, wherein said microparticle comprises silicon.
42. The tagging compound of claim 40, wherein said microparticle comprises silicon dioxide.
43. The tagging compound of claim 40, wherein said microparticle comprises aluminum, silver, or gold.
44. The tagging compound of claim 38, wherein said machine readable code is readable by an optical device.
45. The tagging compound of claim 38, wherein said machine readable code comprises data representing more than one bit.
46. The tagging compound of claim 38, wherein said compound is a gas.
47. The tagging compound of claim 38, wherein said compound is a solid.
48. The tagging compound of claim 38, wherein said compound is a liquid.
49. The tagging compound of claim 38, wherein said compound is paint, ink, or fluid dye.

50. The tagging compound of claim 38, wherein said compound is a smoke dye.
51. The tagging compound of claim 38, wherein said microparticle has a shape representative of a unique code.
52. The tagging compound of claim 38, wherein said microparticle defines pits, holes, or notches that represent a machine readable code.
53. A method of marking an object with an invisible code, comprising applying a tagging compound to said object, wherein said tagging compound comprises a microparticle that is marked with a machine readable code and wherein said microparticle has a thickness of  $0.1\mu$  to  $5.0\mu$ , a width of  $0.5\mu$  to  $50\mu$ , and a length of  $0.5\mu$  to  $50\mu$ .
54. The method of claim 53, wherein said microparticle is formed from a wafer.
55. The method of claim 53, wherein said microparticle comprises silicon, silicon dioxide, or a metal.
56. The method of claim 55, wherein said microparticle comprises silicon.
57. The method of claim 55, wherein said microparticle comprises silicon dioxide.
58. The method of claim 55, wherein said microparticle comprises aluminum, silver, or gold.
59. The method of claim 53, wherein said machine readable code is readable by an optical device.
60. The method of claim 53, wherein said machine readable code comprises data representing more than one bit.
61. The method of claim 53, wherein said compound is a gas.
62. The method of claim 53, wherein said compound is a solid.
63. The method of claim 53, wherein said compound is a liquid.



64. The method of claim 53, wherein said compound is paint, ink, or fluid dye.
65. The method of claim 53, wherein said compound is a smoke dye.

#### Remarks

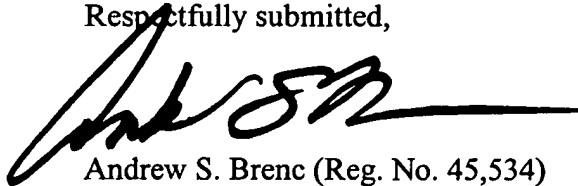
Applicants hereby submit a preliminary amendment for entry prior to examination of the application on the merits. Claims 28-65 have been added, 1-27 have been cancelled, and a paragraph indicating the previously claimed priority of the application has been added. Support for the added claims can be found throughout the specification and in the claims as originally filed. No new matter is introduced by the foregoing amendments, and their entry is respectfully requested.

#### Conclusion

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of the application is respectfully requested.

Respectfully submitted,



Andrew S. Brenc (Reg. No. 45,534)

Date: July 11, 2002

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**Appendix A**  
**Marked Up Specification**

On Page 1, Please delete paragraph [0001] and replace it with the following paragraph:

--The present invention is a continuation-in-part application of United States Serial No. 09/565,426 filed May 5, 2000 entitled CODED MICROPARTICLE IDENTIFICATION LABELS FOR PLACEMENT ON OBJECTS, which is a continuation application of United States Serial No. 08/737,532[ filed October 25, 1996], which is the United States National Phase filing [Under] under 35 U.S.C. § 371 of International Application [PCT/US95/00756] PCT/GB95/00756 filed March [15]31, 1995, which claims the benefit of Great Britain Application GB 9408169.2 filed April 25, 1994, and the present invention is also a continuation-in-part application of United States Serial No. 09/634,514 filed August 8, 2000 entitled CODED PARTICLES FOR PROCESS SEQUENCE TRACKING IN COMBINATORIAL COMPOUND LIBRARY PREPARATION which is a continuation application of United States Serial No. 09/066,296[ filed April 27, 1998], which is the United States National Phase filing under 35 U.S.C. § 371 of International Application PCT/GB96/02617 filed October 25, 1996, which claims the benefit of Great Britain Application GB 9521943.2 filed October 26, 1995.--



## Combined Declaration and Power of Attorney for Patent Application

Docket Number: 17893.006

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter that is claimed and for which a patent is sought on the invention entitled **Coded Items For Labeling Objects**, the specification of which is attached hereto unless the following box is checked:

☒ was filed on December 5, 2001;  
as United States Application Number 10/010,613; and  
was amended on \_\_\_\_\_ (if applicable).

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information that is material to patentability as defined in 37 C.F.R. § 1.56.

I hereby claim foreign priority benefits under 35 U.S.C. § 119(a)-(d) or § 365(b) of any foreign application(s) for patent or inventor's certificate, or § 365(a) of any PCT international application, which designated at least one country other than the United States listed below, and have also identified below any foreign application for patent or inventor's certificate, or PCT international application having a filing date before that of the application on which priority is claimed.

Prior Foreign Application(s)

Priority Claimed

9408169.2  
(Application No.)

Great Britain  
(Country)

25 April 1994  
(Day/Month/Year Filed)

☒ Yes ☐ No

PCT/GB95/00756  
(Application No.)

Great Britain  
(Country)

31 March 1995  
(Day/Month/Year Filed)

☒ Yes ☐ No

I hereby claim the benefit under 35 U.S.C. § 119(e) of any United States provisional application(s) listed below.

\_\_\_\_\_  
(Application No.)

\_\_\_\_\_  
(Filing Date)

\_\_\_\_\_  
(Application No.)

\_\_\_\_\_  
(Filing Date)

I hereby claim the benefit under 35 U.S.C. § 120 of any United States application(s), or under § 365(c) of any PCT international application designating the United States, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States or PCT international application in the manner provided by the first paragraph of 35 U.S.C. § 112, I acknowledge the duty to disclose information that is

material to patentability as defined in 37 C.F.R. § 1.56 that became available between the filing date of the prior application and the national or PCT international filing date of this application.

<u>09/565,426</u>	<u>May 5, 2000</u>	<u>Abandoned</u>
(Application No.)	(Filing Date)	(Status - patented, pending, abandoned)

<u>08/737,532</u>	<u>March 31, 1995</u>	<u>Abandoned</u>
(Application No.)	(Filing Date)	(Status - patented, pending, abandoned)

<u>                    </u>	<u>                    </u>	<u>                    </u>
(Application No.)	(Filing Date)	(Status - patented, pending, abandoned)

I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith:

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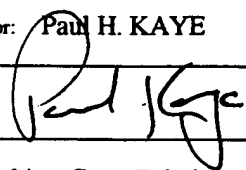
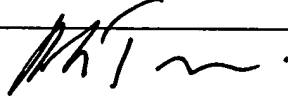
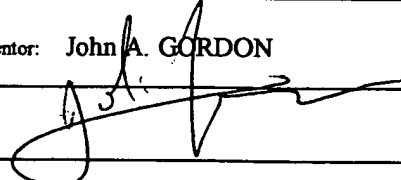
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I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

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